

REMARKS

In the Office Action¹, the Examiner stated that the title is not descriptive; rejected claims 1-4, 6-10, and 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Pub. No. 2004/0157364 to Combi et al. ("*Combi*"); and rejected claims 5, 11, and 12 under 35 U.S.C. §103(a) as unpatentable over *Combi* in view of U.S. Patent Application Pub. No. 2003/0119220 to Mlcak et al. ("*Mlcak*").

Applicants have amended claims 1, 4, 6, and 10. Claims 1-18 are pending, and claims 13 and 15-18 have been withdrawn.

Regarding the title, the Examiner stated, "[t]he title of the invention is not descriptive" (Office Action at page 2). Although Applicants disagree with the Examiner's characterization of the title, Applicants have amended the title to read "SEMICONDUCTOR DEVICE INCLUDING A JETTY PORTION." Applicants submit that the amended title is descriptive.

Applicants respectfully traverse the rejection of claims 1-4, 6-10, and 14 under 35 U.S.C. § 102(b) as being anticipated by *Combi*. In order to properly establish that *Combi* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

This application is the U.S. National Stage of International Application No. PCT/JP05/03302, filed February 28, 2005, which designated the United States. An international application designating the United States shall have the effect of a national application for a patent regularly filed in the U.S. Patent and Trademark Office. See 35 U.S.C. § 363.

Combi has a publication date of August 12, 2004, which is less than one year before the effective U.S. filing date of this application. Therefore, *Combi* is not prior art under 35 U.S.C. § 102(b). Even assuming that *Combi* may be applied as prior art under 35 U.S.C. § 102(e), *Combi* does not teach or suggest the combination of elements as recited in claim 1.

Claim 1 recites a semiconductor device including, for example:

- a substrate having an edge along a dicing line;
- a semiconductor element formed on said substrate;
- a jetty portion, formed between said semiconductor element and said edge on said substrate, having a laminated structure and including an insulating layer and a conducting layer formed on said insulating layer; and

...

(emphasis added). *Combi* does not teach or suggest the claimed "jetty portion."

Combi discloses a micromechanical switch 1 that is "integrated on a first substrate 3" (paragraph 0022 and Fig. 4). The Examiner asserts that frame C of *Combi* corresponds to the claimed "jetty portion" (Office Action at page 3). This is not correct.

As illustrated in Figs. 8-12 of *Combi*, frame C is a conductive, polysilicon layer 10. This layer is deposited and etched according to the steps illustrated in Figs. 8-12. Frame C is made of only a conductive, polysilicon layer 10. However, the

Examiner states that substrate 2 corresponds to the claimed “insulating layer” (Office Action at page 3). Applicants respectfully disagree.

Substrate 2 is not part of frame C. As illustrated in Figs. 7 and 8, layer 10 is deposited on substrate 2. Even assuming that frame C corresponds to the claimed “jetty portion,” substrate 2 is clearly not part of frame C. Moreover, *Combi* explicitly discloses that frame C is only conductive (paragraph 0032). *Combi* does not teach or suggest a “jetty portion” that includes an “insulating layer” and a “conducting layer.” Therefore, *Combi* does not teach or suggest the claimed combination of elements including, for example, “a jetty portion, formed between said semiconductor element and said edge on said substrate, having a laminated structure and including an insulating layer and a conducting layer formed on said insulating layer,” as recited in claim 1.

Accordingly, *Combi* cannot anticipate claim 1. Thus, claim 1 is allowable. Claims 2-4 are also allowable at least due to their depending from claim 1. Independent claim 6 and dependant claims 7-10 and 14, though of different scope from claim 1, are also allowable over *Combi* for at least the same reasons discussed above in regard to claim 1.

Regarding the rejection of claims 5, 11, and 12, dependent from claims 1 and 6, the Examiner relies on *Mlcak* for allegedly disclosing “an electrode pad” (Office Action at pages 6-7). Even assuming this is correct, which Applicants do not concede, *Mlcak* fails to cure the deficiencies of *Combi* discussed above.

Mlcak discloses a micromechanical device (paragraph 0004). However, *Mlcak* does not teach or suggest the claimed combination of elements including, for example,

"a jetty portion, formed between said semiconductor element and said edge on said substrate, having a laminated structure and including an insulating layer and a conducting layer formed on said insulating layer," as recited in claim 1, similarly recited in independent claim 6, and required by dependent claims 5, 11, and 12. Therefore, claims 5, 11, and 12 are also allowable over *Combi* and *Mlcak*.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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